



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,674	02/14/2002	Kenneth K. Sokoll	1151-4172	1691
27123 7590 02/19/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
LE, EMILY M				
ART UNIT		PAPER NUMBER		
1648				
NOTIFICATION DATE		DELIVERY MODE		
02/19/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/076,674

Applicant(s)

SOKOLL, KENNETH K.

Examiner

EMILY LE

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 12/18/2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 4-9, 12, 13, 18 and 19.
Claim(s) withdrawn from consideration: 10, 14-17 and 20-75.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/EMILY LE/
Patent Examiner, Art Unit 1648

Continuation of 11. does NOT place the application in condition for allowance because: The status identifier Applicant has provided for claim 1 is incorrect. Instead of being listed as "Currently presented", the identifier should be "Currently amended". Additionally, contrary to Applicant's assertion, the rejection(s) does not include claim 10. While claim 10 is pending, it is not being examined for it has been withdrawn from examination for being directed at a non-elected species or invention. See MPEP § 800.

Applicant's arguments have been considered, however, it is not persuasive. The claims remain rejected for the reason(s) of record. In the instant case, it is noted that Applicant strongly argued that Krieg et al. does not teach an anionic polynucleotide. Contrary to Applicant's assertion, Krieg does teach an anionic polynucleotide. As noted in the rejection, Krieg et al. teaches SEQ ID NO: 429, which is the same as the anionic polynucleotide sequence recited in the rejected claims, particularly claim 13. While it is noted that Krieg et al. does not teach a method of calculating the anionic charge of the polynucleotide, however, this absence does not result in failure on the part of Krieg et al. to teach an anionic polynucleotide because Krieg et al. does teach the claimed anionic polynucleotide. Since Krieg et al. teaches the same polynucleotide as those claimed, the polynucleotide of Krieg et al. would necessarily have the same properties as the claimed polynucleotide. Moreover, "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See MPEP § 2112.

Additionally, while it is noted that Krieg et al. does teach of other polynucleotides, such as those that are pyridine rich polynucleotides, it remains that Krieg et al. also teaches the claimed polynucleotide. It is further noted that Applicant argued that Krieg et al. does not teach or suggest how to select a peptide that is cationic or how to render a peptide cationic, however, Applicant is reminded that the claimed invention is neither directed at how to measure anionic charge or render a peptide cationic. Moreover, the deficiency noted of Krieg et al., as noted in the rejection, is fully compensated by Ladd et al. for the reason(s) set forth in the rejection and that the rejection of record is an obviousness rejection rather than an anticipatory rejection. Regarding Applicant's assertion that Krieg et al. teaches against the addition of phosphorothioate moiety to the backbone of CpG containing polynucleotide, this has been considered, however, it is unclear how this is of relevance. The claimed invention encompasses polynucleotides having either phosphorothioate or phosphodiester backbones. Additionally, contrary to Applicant's assertion, Krieg et al. also teaches the addition of phosphorothioate moieties. See page 36 of Krieg et al.

It is noted that Applicant attacked the Ladd disclosure separately. Applicant is reminded that "[O]ne cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In *re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In *re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP § 2145.

Additionally, it appears that Applicant is arguing that the Office has inappropriately used Applicant's disclosure. Applicant is reminded that the claims are interpreted in view of the specification, Applicant's disclosure. In the instant case, the Office has not used Applicant's disclosure as prior art, as alleged by Applicant.